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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/815,368	04/01/2004	Ian Eisenberg	1281-0086	2885
55959 7590 01/10/2008 NEWMAN & NEWMAN, ATTORNEYS AT LAW, LLP 505 FIFTH AVENUE SOUTH SUITE 610 SEATTLE, WA 98104			EXAMINER LEVINE, ADAM L	
			ART UNIT 3625	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No. 10/815,368	Applicant(s) EISENBERG, IAN	
	Examiner Adam Levine	Art Unit 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 17-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 17-36 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>30 October 2007</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 30, 2007, has been entered.

### ***Response to Amendment***

Applicant's amendments and remarks filed October 30, 2007, are responsive to the office action mailed May 30, 2007. Originally filed claims 1-16 were previously cancelled and claims 17-36 filed in their stead. Claims 17, 18, 26, and 36 are currently amended. Claims 17-36 are therefore currently pending and considered in this office action.

#### **Pertaining to objections to the specification (copyright notice) in a previous office action**

It appears that applicant attempted to delete the improper copyright notice in applicant's submission of February 9, 2007, however, the amendments to the specification were not entered because the specification amendment as a whole was held to be non-compliant. This amendment should therefore be resubmitted, taking care to ensure that it is submitted in compliant form.

Pertaining to other amendment to the specification

With regard to the other amendments to the specification submitted on February 9, 2007, amendments to the specification were not entered because the specification amendment was held to be non-compliant. Because the amendment to the title is the only specification amendment that has been resubmitted, the amendment of the title is the only specification amendment that has been entered. All other amendments to the specification should therefore be resubmitted, taking care to ensure that they are submitted in compliant form.

Pertaining to objections to the claims in the previous office action

Claims 26 and 36 were objected to due to informalities. The informalities have been corrected and the objections are withdrawn.

Pertaining to rejection under 35 USC §112 in the previous office action

Claims 17-18, and 26 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because there was insufficient antecedent basis for limitations in the claims. The amendments have adequately addressed the problem and the rejection is withdrawn.

***Response to Arguments***

Pertaining to rejection of claims 17-36 under 35 USC §112 in the previous office action

With regard to the rejection of claims 17-36, applicant's arguments filed October 30, 2007, have been fully considered but they are not persuasive. Examiner understands applicant's explanation that the 'short code' is inherent in the 'telephone number,' and requests that the applicant bear this in mind with regard to the future consideration of prior art that discloses one but not the other. The difficulty is not in the specific identification of the information that is transmitted by SMS, however, but rather it is in the implication that an additional functionality is present though not clearly claimed nor disclosed in the specification as originally filed.

The claim element, "sending SMS message(s) to the would-be purchaser containing a short code and/or a telephone number through which the would-be purchaser may obtain the goods and/or services" was not disclosed in the originally filed specification or claims in any way that would have sufficiently put one of ordinary skill in the art on notice that this feature was intended to be encompassed within the disclosed invention. Examiner has reviewed the originally filed specification and understands that this feature could arguably have been partially enabled by information in paragraphs 0009 and 0035 of the originally filed specification, but only if the feature had itself actually appeared anywhere in the specification or claims (paragraphs cited as numbered in the published specification 2005/0251454 A1). It did not.

Paragraph 0009 describes admitted prior art as background. The prior art teaches transmission of a telephone number via SMS. Paragraph 0035 describes

providing services by way of a telephone number in lieu of a PIN number, where the service provider activates the phone number upon receiving an SMS agreeing to terms. Unfortunately, these portions do not appear in any sort of proximity or context that would suggest that their combination was intended to be included within the present inventive concept as it was intended when the specification was filed. There is simply no clear disclosure of "sending SMS message(s) to the would-be purchaser containing a short code and/or a telephone number through which the would-be-purchaser may obtain the goods and/or services," and certainly no disclosure that would put one of ordinary skill in the art on notice that this feature was intended to be encompassed within the invention as originally disclosed.

Pertaining to rejection of claim 27 under 35 USC §112 in the previous office action

Claim 27 was rejected under 35 U.S.C. 112, first paragraph, because "an automated telephone response system" was not described in the specification. Applicant's explanation, see remarks filed October 30, 2007, with respect to claim 27, has been fully considered and is persuasive. It is understood based on applicant's explanation that "an automated telephone response system," as described in figs. 4-6 and paragraph 0036 of the specification, is any system capable of playing an automated message in response to a call from a caller.

Pertaining to rejection under 35 USC §102(b) in the previous office action

Applicant's arguments with respect to claims 17-36 have been considered but are moot in view of the new ground(s) of rejection.

Pertaining to rejection under 35 USC §103(a) in the previous office action

Applicant's arguments with respect to claims 20 and 35 have been considered but are moot in view of the new ground(s) of rejection. It is noted however that applicant's argument that the steps "are not necessarily repeated," and that "it is not necessary to repeat all of the other steps" is irrelevant since the claim language is directed at a repetition of one step and the result is exactly the result that a person of ordinary skill would expect from said repetition. The fact that the precise information included in the message may not be exactly the same is also irrelevant as the information contained within the message is purely nonfunctional descriptive information.

Pertaining to the provisional double patenting rejection in the previous office action

Applicant argues that the filing of a terminal disclaimer in one application (application number 11/089843) is sufficient to overcome this rejection. It is not. A terminal disclaimer must be filed with regard to both applications.

***Specification***

A copyright notice appears at the bottom of the first page of the specification. This notice will not be permitted. A copyright or mask work notice may be placed in a design or utility patent application adjacent to copyright and mask work material contained therein. The notice may appear at any appropriate portion of the patent application disclosure. For notices in drawings, see § 1.84(s). The content of the notice must be limited to only those elements provided for by law. For example, "©1983 John

Doe" (17 U.S.C. 401) and "\*M\* John Doe" (17 U.S.C. 909) would be properly limited and, under current statutes, legally sufficient notices of copyright and mask work, respectively. Inclusion of a copyright or mask work notice will be permitted only if the following authorization language is included at the beginning (preferably as the first paragraph) of the specification. 37 CFR 1.71(d).

The authorization shall read as follows:

A portion of the disclosure of this patent document contains material which is subject to (copyright or mask work) protection. The (copyright or mask work) owner has no objection to the facsimile reproduction by any-one of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent file or records, but otherwise reserves all (copyright or mask work) rights whatsoever. 37 CFR 1.71(e).

The inclusion of a copyright or mask work notice in a design or utility patent application, and thereby any patent issuing therefrom, under the conditions set forth above will serve to protect the rights of the author/inventor, as well as the public, and will serve to promote the mission and goals of the U.S. Patent and Trademark Office. Therefore, the inclusion of a copyright or mask work notice which complies with these conditions will be permitted. However, any departure from these conditions may result in a refusal to permit the desired inclusion. If the authorization required under condition (C) above does not include the specific language "(t)he (copyright or mask work) owner has no objection to the facsimile reproduction by anyone of the patent document or the patent disclosure, as it appears in the Patent and Trademark Office patent files or records,..." the notice will be objected to as improper by the examiner of the application. If the examiner maintains the objection upon reconsideration, a petition may be filed in accordance with 37 CFR 1.181. See MPEP §608.01(v) II. Examiner notes here that it



appears applicant is claiming the entire application as subject to the copyright of the applicant. This is not permissible as it is inconsistent with the above. Appropriate correction is required.

The specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. **Claims 17-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claim element, "sending SMS message(s) to the would-be purchaser containing a short code and/or a telephone number through which the would-be purchaser may obtain the goods and/or services" was not disclosed in the originally filed specification or claims in any way that would have sufficiently put one of ordinary skill in the art on notice that this feature was intended to be encompassed within the disclosed invention.

Paragraph 0009 of the specification describes admitted prior art as background. (Paragraphs cited as numbered in the published specification 2005/0251454 A1). The prior art teaches transmission of a telephone number via SMS. Paragraph 0035 describes providing services by way of a telephone number in lieu of a PIN number, where the service provider activates the phone number upon receiving an SMS agreeing to terms. Unfortunately, these portions do not appear in any sort of proximity or context that would suggest their combination in the very specific way required to adequately describe the presently claimed feature. There is simply no clear disclosure of "sending SMS message(s) to the would-be purchaser containing a short code and/or a telephone number through which the would-be-purchaser may obtain the goods and/or services," and certainly no disclosure that would put one of ordinary skill in the art on notice that this feature was intended to be encompassed within the invention as originally disclosed.

2. **Claims 17-36 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "Receiving from a telecommunications service provider an amount related to an amount billed by the telecommunications service provider to the would-be-purchaser for use of the short code and/or a specialty purpose telephone number" was not disclosed in the originally filed specification.

3. **Claims 21,24,30, and 32 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement.** The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "Terminating use of the short code or telephone number" by the would-be-purchaser was not disclosed in the originally filed specification.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. **Claims 17-36 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

The term "related to" in claims 17 and 26 is a relative term that renders the claim indefinite. The term "related to" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. This appears with regard to "an amount related to an amount billed...".

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**5. Claims 17-36 are rejected under 35 U.S.C. 102(e) as being anticipated by Wood (US Pub. No. 2005/0251454 A1, based on filing date of provisional application no. 60/466,873; May 8, 2003).**

Wood teaches all the limitations of claims 17-36. For example, with regard to claims 17-19 and 21-25, Wood discloses a method for conducting an offer, purchase, and supply of goods and/or services with a would-be-purchaser in possession of an SMS enabled phone. Wood further discloses:

- engaging in a phone call with the would-be purchaser: offering through the call that the would-be-purchaser may accept an offer to purchase goods and/or services and receiving through the call acceptance of such offer (see at least abstract, page 1 ¶¶0005-0006; page 2 ¶0026, page 3 ¶¶0034-0038);
- sending confirmation SMS message(s): to the would-be-purchaser's phone, SMS message(s) comprise some or all of: information regarding goods and/or services available for use for a first period of time and/or a period of time subsequent to the first period of time, terms of purchase, a fee schedule, a request for an additional acceptance by the would-be-purchaser of the offer, sending confirmation SMS message(s) and SMS message(s) to the would-be-purchaser's phone further comprises sending such message(s) utilizing SMS message

delivery confirmation (see at least page 6 ¶¶0080-0081. Please note: The information present in the SMS message is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106);

- receiving from the would-be-purchaser acceptance of the payment terms: relative to a sent SMS message (see at least abstract, fig.2, page 1 ¶¶0006-0009,0012; page 2 ¶¶0024-0026); the would-be-purchaser sending at least one reply to a sent confirmation SMS message with an indication of acceptance included in the body of the at least one reply SMS message (see at least abstract, fig.2, page 1 ¶¶0006-0009,0012; page 2 ¶¶0024-0026).
- sending SMS message(s) to the would-be-purchaser containing a short code and/or a telephone number: through which the would-be-purchaser may obtain the goods and/or services, terminating use of the short code or telephone number by the would-be-purchaser upon lapse of the then-extant period of time, sending to the would-be-purchaser an SMS message containing a PIN code, utilizing the PIN code to control access to the goods and/or services, associating the PIN code with the period of time acquired by the would-be-purchaser and

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terminating the use of the short code and/or telephone number upon lapse of the period of time associated with the PIN code, sending the PIN code to a third party provider of the goods and/or services (see at least abstract, page 1 ¶¶0005, page 2 ¶¶0028-0031, page 5 ¶¶0061-0072. Please note: The exact form taken by the content of the SMS message is descriptive material and is not functionally involved in the recited steps of the method. Because it has no functional role in the method it is non-functional descriptive material. This descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983). MPEP 2106). In other words, whether the content takes the form of a telephone number, short code, or other alphanumeric string used to access the product, the function is the same, so the form that it takes is not distinguishing).

- receiving from a telecommunications service provider an amount: related to an amount billed by the telecommunications service provider to the would-be-purchaser for use of the short code and/or a specialty purpose telephone number (see at least figs.2,10; page 1 ¶¶0006-0010, page 2 ¶¶0022-0026, page 3 ¶¶0034-0045); provider of the goods and/or services also performs a step of billing the would-be-purchaser according to the accepted payment terms (see at least figs.2,10; page 1 ¶¶0006-0010, page 2 ¶¶0022-0026, page 3 ¶¶0034-0045).

Pertaining to system claims 26-36

Rejection of system claims 26-36 is based on the same rationale as noted above.

In addition, Wood discloses:

- a component: to engage in a phone call, determine the phone number of the would-be-purchaser, send SMS message(s) using SMS message delivery confirmation, receive from a telecommunications service provider an amount, bill the would-be-purchaser according to the accepted offer, terminate use of the short code or telephone number, control access to the goods and/or services, associate the PIN code with the period of time, generate a PIN code (see at least abstract, figs. 1-8; page 1 ¶¶0002-0010, page 2 ¶¶0022-0026); an automated telephone response system, an automated SMS message handling system (see at least page 1 ¶¶0002-0010, page 2 ¶¶0031-0032, page 3 ¶0035)
- an SMS enabled phone: (see at least abstract).

***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 17-36 are provisionally rejected on the ground of nonstatutory double patenting over claims 17-36 of copending Application No. 11/089843. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows: A method for purchase of goods and/or services comprising a phone call between a would-be purchaser and a service provider/vendor, a text or multimedia message being forwarded to the would-be purchaser's mobile phone device relating to purchase of services and/or goods, or purchase options and/or terms of procuring services and/or goods, and upon acceptance of the contents of the text or multimedia message, the would-be purchaser or caller is billed or charged a fee which allows the caller's access to telephonic and/or Internet vendor provided services and/or goods for a first determined time period.

Furthermore, there is no apparent reason why applicant would be prevented from presenting claims corresponding to those of the instant application in the other



copending application. See *In re Schneller*, 397 F.2d 350, 158 USPQ 210 (CCPA 1968). See also MPEP § 804.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Kim, US Pub. No. 2004/0068448 A1 (April 8, 2004): Teaches electronic financial transaction system and method providing real-time authentication service through wireless communication network. Discloses negotiation and confirmation of transactions by way of wireless electronic messaging.
- Reisman, US Patent No. 6,594,692 B1 (July 15, 2003): Teaches methods for transacting electronic commerce. Discloses negotiation of transactions and distribution of electronic information products via telephone.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Adam Levine whose telephone number is 571.272.8122. The examiner can normally be reached on M-F, 8:30-5:00 Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571.272.6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Adam Levine  
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January 4, 2008

  
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